

REMARKS

Claims 1-20 remain in the case, and new Claims 21-23 are added in this amendment. Claims 1-3, 9-14, 18 and 19 were rejected as being obvious over the combination of the Imai reference together with Brown et al. Claims 4-8 and 15 were rejected as "an obvious engineering choice(s)" over the combination of the Imai and Brown references. Claims 16 and 17 were rejected on the grounds that side panels in eyewear are commonly known in the art. Method Claim 20 was effectively rejected on the same grounds as Claim 1. Applicant respectfully traverses these grounds of rejection and requests reconsideration in view of the remarks set out below.

I. Applicant's Invention

As recited in Claim 1, Applicant's invention comprises, inter alia, a plastic lens shaped for use as eyewear with decorative particles *embedded* in at least a portion of the lens. As more specifically recited in dependent Claim 4, the decorative particles comprise glitter which is dispersed *through* the central portion and the intermediate portion between the front and back of the lens. The remaining claims all recite specific alternative arrangements for eyewear having lens containing the glitter in various patterns or locations *within* the lens itself. Further, while dependent Claim 8 recites that the lens comprises "a one-way mirror along a portion of the back of the lens," there is no recitation that the glitter is contained within the layer of the one-way mirror.

New Claim 21 is added in this amendment to specifically point out that the lens having glitter between the front and back of the lens does not contain any glitter-containing surface layer.

II. The Combination of the Imai and Brown et al. References Do Not Disclose Glitter Within the Lens

The Imai reference discloses eyewear “*on which* characters, figures, patterns, marks and so on are printed, dyed, applied, etched or the like.” (Emphasis added). By utilizing the language “on which,” Imai makes it clear that the “characters, figures, patterns, marks and so on” are applied onto the surface of the colored substrates fabricated from glass. The reference is entirely devoid of any suggestion for dispersing any material *within* the lens themselves.

The Brown et al. reference, at column 2, lines 20-29 specifically points out that the glitter material is formed as a film of polycarbonate, which is placed inside a mold and then a lens or other material is injected into the mold:

The method of the present invention disperses homogeneously throughout a solvated polycarbonate resin, the dyes, which may be photochromic, and/or a metallic additive. *The solvent mixture is then cast to form a film of polycarbonate having the dye and/or metallic additive homogeneously dispersed therein. The cast film can be placed in a mold against a mold wall and a substrate resin injected into the mold behind the insert.* The article is thus molded without exposing the dye to high temperature for long periods of time, thus avoiding degradation of the dye. (Emphasis added).

Thus, if one were to combine the teachings of Imai and Brown et al., one skilled in the art would be left with a lens having a *surface film with the glitter material in the*

film, and not within the lens. In contrast, Applicant's disclosure and claims make it clear that the glitter is disposed *in the lens itself*.

III. The Language of the Claims Distinguishes Over the Applied References

The language of all of the claims make clear that the decorative particles are "embedded in at least a portion of the lens" (Claim 1), and "is dispersed through the central portion and intermediate portion between the front and back of the lens" (Claim 4).

Claim 11 likewise recites that the "decorative glitter (is) dispersed in a portion in at least one of the lens," which limitation is also recited in independent Claim 18. Method Claim 20 further recites the step of "dispersing a decorative glitter *through* at least a portion of the lens". New Claim 21 recites specifically that the front and back of the lens are free of any overlying glitter-containing film.

Accordingly, it is respectfully submitted that each of the independent claims in the application make clear that the decorative glitter is dispersed *in the lens*, and not on a surface film.

IV. Neither the Imai Nor Brown et al. References Contains a Suggestion for Combining Their Teachings

Decisions in the federal circuit make it quite clear that, when considering the issue of obviousness, there must be evidence of a teaching, motivation or suggestion to combine the references. Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1348, 53 USPQ 2d 1580, 1586 (Fed. Cir. 2000), cert. denied 530 US 1238

(2000); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997) (noting that the absence of a suggestion to combine is dispositive in an obviousness determination); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references"); and In re Dance, 160 F.3d 1339, 1343, 48 USPQ 2d 1635, 1637 (Fed. Cir. 1998) ("To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made...").

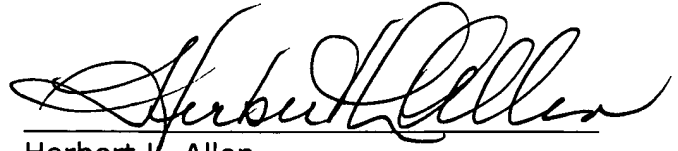
In this instance, Imai discloses that the "characters, figures, patterns, marks and so on" are some how, printed, dyed, applied or etched on the glass lens. In contrast, Brown et al. disclose mixture of, *inter alia*, glitter with a polycarbonate material which is then disposed in a film to which another body of material is attached in a mold. The combined teachings of these references simply do not lead one of ordinary skill in the art to make the leap which has been made by Applicant to dispose the glitter within the lens itself.

IV. Summary and Conclusion

For the reasons set out above, Applicant respectfully submits that Claims 1-23 are allowable, and passage to issue is therefore respectfully solicited. If the further prosecution of this application can be facilitated through a telephone interview between

the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,



Herbert L. Allen
Registration 25,322
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Ave., Suite 1401
P. O. Box 3791
Orlando, Florida 32802
Telephone (407) 841-2330
Facsimile (407) 841-2343

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